

REMARKS

Applicants respectfully request further examination and consideration in view of the arguments set forth fully below. Within the Office Action mailed on November 28, 2008, Claims 1-17 and 23-31 have been rejected. Accordingly, Claims 1-17 and 23-31 are currently pending.

Rejections Under 35 U.S.C. § 112

Claims 27 and 28 stand rejected under 35 U.S.C. 112 as being failing to comply with the written description requirement. The Applicants respectfully disagree.

The language “plurality of menu trees” is clearly supported in the current specification in Figures 1B through 3C. For instance, Fig. 1B shows a “messaging” menu tree and Fig. 3C shows a “call log” menu tree. Thus, the specification of the present invention does convey to a person of ordinary skill the meaning of “plurality of menu trees.”

The language “orthogonal paths” is clearly supported in the current specification in Figure 1A and lines 4-5, page 8 of the written description, which states “the two-dimensional navigation key 115 has two orientations, wherein 130 and 150 are a vertical, first orientation and 140 and 160 are a horizontal, second orientation.” A person of ordinary skill would know the first and second orientations are “orthogonal” to each other. Further, a person of ordinary skill would know a “first orthogonal path” corresponds to the “first orientation” and that the “second orthogonal path” corresponds to the “second orientation.” Thus, the specification of the present invention does convey to a person of ordinary skill the meaning of “orthogonal paths.” Accordingly, Applicants have respectfully request withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103

Claims 1-15, 17 and 23-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0064757 to Yamadera et al. (hereinafter “Yamadera”) in view of U.S. Patent No. 7,188,320 to Landers (hereinafter “Landers”). Applicants respectfully traverse this rejection because neither Yamadera, Landers nor their combination teach the present claimed invention.

Yamadera teaches a method of displaying information on a screen of a cell phone that includes a cursor key (4). Yamadera merely teaches the cursor key (4) being moved in four directions and being used to select menu items for a display screen. [Yamadera, para. 0042] Yamadera also teaches soft keys (3a, 3b) and associated icons (14, 15) that display a function of

the soft keys (3a, 3b), respectively. [Yamadera, para. 0046] Yamadera does not teach that an application can be selected by the navigation key.

As acknowledged by the Examiner, Yamadera does not teach a device wherein the two dimensional key is configured as a single button and wherein the four sets of contact points are used to select and perform an action corresponding to one of a plurality of main menu items. If this is true, Yamadera further does not teach the limitation of a device wherein the two dimensional key is configured as a single button and wherein the four sets of contact points are used to select and perform an action corresponding to “a sub-menu item of the sub-menu associated with a selected main menu item.” Landers appears to be cited for this purpose.

Landers teaches a graphical user interface for wireless communications. Landers teaches that a navigation routine changes the operation of the navigation key such that when the point of focus is on the last menu, pressing the down arrow moves the point of focus to a first item in the last menu. Landers teaches that invoking the routine from a last menu item in the last menu merely moves the point of focus back to the first menu item of the last menu. [Landers, Col. 4, lines 55-67] In sharp contrast to the present invention, Landers would still require the user to press a soft key, such as a soft key with the label “compose”, in order to perform the indicated action of composing to a buddy, for example in the buddy list. [Landers, Col. 3, lines 48-54]

The Examiner asserts that “Landers discloses that both a menu and sub-menu items can be selected and indicated action may be performed on the selected item using the navigation key.” The Applicants respectfully disagree. Nowhere in Landers is this assertion explicitly taught. It is only when the benefit of improper hindsight that this assertion is made. This is not in fact taught in Landers, Yamadera or their combination. Rather a soft key B required to select an application.

This is a classic case of impermissibly using hindsight to make a rejection based on obviousness. The Court of Appeals for the Federal Circuit has stated that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In Re Fritch, 972 F.2d, 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). As discussed above, Yamadera and Landers do not teach “a two-dimensional navigation key configured as a single-button including four sets of contact points, wherein the two-dimensional navigation key is configured to select and perform an action corresponding to one of a plurality of main menu items of the main menu and to select and perform an action corresponding to a sub-menu item of the sub-menu associated with a

selected main menu item using the four sets of contact points” (emphasis added). Within the Office Action, it is stated that:

it would have been obvious to one of ordinary skill in the art to combine the teachings of Landers with the teachings of Yamadera to arrive at the claimed invention. [Office Action, page 8]

It is only with the benefit of the present claims, as a “template” that there is any motivation to combine Yamadera with Landers. No such motivation can be found in the teachings of either of the references. To conclude that the combination of Yamadera and Landers is obvious, based on the teachings of these references, is to use hindsight based on the teachings of the present invention and to read much more into Yamadera and Landers than their actual teachings. This is simply not permissible based on the directive from the Court of Appeals for the Federal Circuit.

It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference, or references, must teach or suggest all the claim limitations. MPEP § 2143.

The burden of establishing a *prima facie* case of obviousness based on the teachings of Yamadera and Landers has not been met within the Office Action.

As detailed above, neither Yamadera nor Landers nor their combination teach or suggest the limitations of the present invention. Further, there is no hint or suggestion that the teachings of Yamadera and Landers should be combined. To conclude that the combination of Yamadera and Landers is obvious, based on the teachings of these references, is to use hindsight on the teachings of the present invention and to read much more into Yamadera and Landers than their actual readings. Based on the directive from the Court of Appeals for the Federal Circuit, it is impermissible to use hindsight to combine the references in a piecemeal fashion. The Applicants reaffirm that there is no teaching, suggestion, or motivation to combine Yamadera and Landers.

Even if considered proper, the combination of Yamadera and Landers does not teach “a two-dimensional navigation key configured as a single-button including four sets of contact

points, wherein the two-dimensional navigation key is configured to select and perform an action corresponding to one of a plurality of main menu items of the main menu and to select and perform an action corresponding to a sub-menu item of the sub-menu associated with a selected main menu item using the four sets of contact points” (emphasis added).

The independent Claim 1 is directed to a menu-driven electronic device. The device of Claim 1 comprises a display configured to selectively display at least one of a plurality of menus, including a main menu and a sub-menu. A two-dimensional navigation key is configured as a single-button including four sets of contact points, wherein the two-dimensional navigation key is configured to select and perform an action corresponding to one of a plurality of main menu items of the main menu and to select and perform an action corresponding to a sub-menu item of the sub-menu associated with a selected main menu item using the four sets of contact points. As described above, Yamadera does not teach a two-dimensional navigation key including four sets of contact points configured to select and perform an action, and Landers does not teach a single-button two-dimensional navigation key configured to select and perform an action corresponding to a sub-menu item of a sub-menu associated with a selected main menu item. For at least these reasons, the independent Claim 1 is allowable over Yamadera in view of Landers.

Claims 2-15 and 17 are dependent upon the independent claim 1. Accordingly, Claims 2-15 and 17 are allowable as being dependent upon an allowable base claim.

The independent Claim 23 is directed to a menu-driven wireless telecommunications device. The device of Claim 23 comprises a display configured to selectively display at least one of a plurality of menus, including a main menu, a first sub-menu, and a second sub-menu. A two-dimensional navigation key is configured as a single-button including four sets of contact points, wherein the two-dimensional navigation key is configured to select and perform an action corresponding to one of a plurality of main menu items of the main menu, to select and perform an action corresponding to a first sub-menu item of the first sub-menu associated with a selected main menu item, and further to select and perform an action corresponding to a second sub-menu item of the second sub-menu associated with the selected main menu item using the four sets of contact points. As described above, Yamadera does not teach a two-dimensional navigation key including four sets of contact points configured to select and perform an action, and Landers does not teach a single-button two-dimensional navigation key configured to select and perform an action corresponding to a sub-menu item of a sub-menu associated with a selected main menu item. For at least these reasons, the independent Claim 23 is allowable over Yamadera in view of Landers.

Claims 24-26 are dependent upon the independent claim 23. Accordingly, Claims 24-26 are allowable as being dependent upon an allowable base claim.

The independent Claim 27 is directed to a menu-driven wireless telecommunications device. The device of Claim 27 comprises a display configured to selectively display at least one of a plurality of menu trees, including a plurality of main menus, each having a plurality of sub-menus. A two-dimensional navigation key is configured as a single-button configured to operate along two orthogonal paths such that each of the orthogonal paths has two directions along the path wherein operating the key along a first of the orthogonal paths selects a preferred main menu from among the plurality of main menus, operating the key along a second of the orthogonal paths selects a preferred sub-menu among the plurality of sub-menus, and operating the key along the first orthogonal path activates the selected sub-menu. As described above, Yamadera does not teach a two-dimensional navigation key including four sets of contact points configured to select and perform an action, and Landers does not teach a single-button two-dimensional navigation key configured to select and perform an action corresponding to a sub-menu item of a sub-menu associated with a selected main menu item. For at least these reasons, the independent Claim 27 is allowable over Yamadera in view of Landers.

Claims 28-31 are dependent upon the independent claim 27. Claims 28-31 are allowable as being dependent upon an allowable base claim.

Within the Office Action, claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamadera in view of Landers and further in view of U.S. Patent No. 6,463,304 to Smethers. Claim 16 is dependent on the independent claim 1. As discussed above, the independent claim 1 is allowable over the teachings of Yamadera in view of Landers. Accordingly, claim 16 is allowable as being dependent upon an allowable base claim, and is now in condition for allowance.

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Conclusion

For the reasons given above, Applicants respectfully submit that the claims 1-17 and 23-31 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
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Dated: 2-9-09

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HAVERSTOCK & OWENS LLP.

Date: 2/10/09 By: SA